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EXAMINER

COUSO, JOSE L

ART UNIT PAPER NUMBER

2621

DATE MAILED: 10/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/729,021

Applicant(s)

LIM ET AL.

Examiner

Jose L. Couso

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. 09/486,991.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/8/03.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

Art Unit: 2621

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 and 16-17 of U.S. Patent No. 6,707,944. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed towards the same subject matter.

The claims in the present application define the invention differently from the claims in the issued U.S. Patent No. 6,707,944, however they are not patentably distinguishable from the claims in the other copending applications. *In re White et al.*, 160 USPQ 417, *In re Thorington et al.*, 163 USPQ 644.

For example comparing representative claim 1 of the present application with representative claim 1 of issued U.S. Patent No. 6,707,944: Claim 1 of the present application recites: A computational graceful degradation method in a system comprising an encoder for encoding multimedia objects and multiplexing a plurality of

Art Unit: 2621

encoded multimedia object bitstreams to transmit a multiplexed multimedia object bitstream and a decoder for demultiplexing the multiplexed multimedia object bitstream received from the encoder, and decoding corresponding multimedia object bitstream for reconstruction to generate reconstructed multimedia to user, the method comprising the steps of: (Claim 1 of issued U.S. Patent No. 6,707,944 recites: A computational graceful degradation method in an MPEG encoder and decoder system comprising: an encoder including a multimedia object dividing unit for dividing input multimedia into a plurality of objects according to its content and characteristic, a plurality of object encoding units for encoding the corresponding input multimedia objects from the multimedia object dividing unit, a multiplexer for multiplexing a plurality of encoded multimedia object bitstreams to transmit a multiplexed multimedia object bitstream, and a decoder including a demultiplexer for demultiplexing the multiplexed multimedia object bitstream received from the multiplexer to output a plurality of demultiplexed multimedia object bitstream, a plurality of object decoding units for decoding the corresponding multimedia object bitstream applied from the demultiplexer, and a multimedia constructing unit for reconstructing the decoded multimedia objects to generate reconstructed multimedia to user, the method comprising the steps of:); Claim 1 of the present application continues to recite: determining, in the encoder, a priority of the respective objects according to a relative importance between the objects before multiplexing the encoded object bitstream for transmission, considering that the computational graceful degradation will be applied in the decoder (Claim 1 of issued U.S. Patent No. 6,707,944 continues to recite: determining, in the multiplexer, a priority of the respective objects according to a

Art Unit: 2621

relative importance between the objects before multiplexing the encoded object bitstream for transmission, considering that the computational graceful degradation will be applied in the decoder); Claim 1 of the present application continues to recite: and determining, in the decoder, an amount of computational power to be degraded in different ratio every object using priority information determined according to the respective objects (Claim 1 of issued U.S. Patent No. 6,707,944 continues to recite: and determining, in the demultiplexer, an amount of computational power to be degraded in different ratio every video object using priority information determined according to the respective objects).

As the comparison shows the differences are merely in where the determination is carried out in the two recited steps. In the present claims the determination of the priority of the respective objects, in the first step, and the determining of an amount of computational power, in the second step, are carried out in the decoder. In the patented claims the determination of the priority of the respective objects, in the first step, and the determining of an amount of computational power, in the second step, are carried out in the demultiplexer. Both functions are carried out on the data and/or elements and in no way affects how the data would be received from an input, processed and output within the context of the claims. Therefore, the substitution of the equivalent functions in either one element or another, i.e. decoder or demultiplexer, would have been obvious to one of ordinary skill in the art at the time of the claimed invention.

Claim 2 of the present application is word for word the same as claim 2 of issued U.S. Patent No. 6,707,944.

Comparing claim 3 of the present application with claim 3 of issued U.S. Patent No. 6,707,944: Claim 3 of the present application recites: A method for generating an object bitstream to be transmitted to an MPEG decoder system, the object bitstream corresponding to a plurality of objects of multimedia data, wherein each of the objects in the object bitstream is encoded, and priority information of respective objects according to a relative importance between respective objects is determined before multiplexing an encoded object bitstream for transmission to the MPEG decoder system (Claim 3 of issued U.S. Patent No. 6,707,944 recites: A method for generating an object bitstream to be transmitted to an MPEG decoder system, the object bitstream corresponding to a plurality of objects of multimedia data, wherein each of the objects in the object bitstream is encoded, and priority information of respective objects according to a relative importance between respective objects is determined before multiplexing an encoded object bitstream for transmission to the MPEG decoder system).

Comparing claim 4 of the present application with claim 4 of issued U.S. Patent No. 6,707,944: Claim 4 of the present application recites: An object bitstream transmitted from an MPEG encoder system to an MPEG decoder system, via a transmission medium, the object bitstream corresponding to a plurality of objects of multimedia data, wherein each of the objects in the object bitstream is encoded, and priority information of respective objects according to a relative importance between respective objects is determined before multiplexing an encoded object bitstream for transmission to the MPEG decoder system (Claim 4 of issued U.S. Patent No. 6,707,944 recites: An object bitstream transmitted from an MPEG encoder system to an

Art Unit: 2621

MPEG decoder system, via a transmission medium, the object bitstream corresponding to a plurality of objects of multimedia data, wherein each of the objects in the object bitstream is encoded, and priority information of respective objects according to a relative importance between respective objects is determined before multiplexing an encoded object bitstream for transmission to the MPEG decoder system).

The comparison of claims 3 and 4 shows that the only difference is that in the present claims applicant recites "objects" whereas in the issued claims applicant recites "video objects". Both "objects" are in an MPEG decoder system and the processing is carried out on the data and/or elements and in no way affects how the data would be received from an input, processed and output within the context of the claims.

Therefore, the substitution of the "object" for "video object" would have been obvious to one of ordinary skill in the art at the time of the claimed invention.

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Chung et al. discloses system similar to applicant's claimed invention.

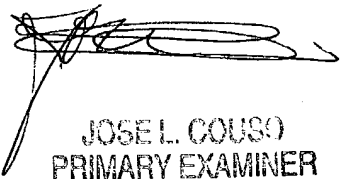
Art Unit: 2621

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jose L. Couso whose telephone number is (703) 305-4774. The examiner can normally be reached on Monday through Friday from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Boudreau, can be reached on (703) 305-4706. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-8576.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JOSE L. COUSO  
PRIMARY EXAMINER

Jlc  
October 5, 2004